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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,486	11/27/2001	Krishna Sundaresan	081862.P251	2696

7590 08/31/2005

Robert B. O'Rourke  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
Seventh Floor  
12400 Wilshire Boulevard  
Los Angeles, CA 90025-1026

EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/996,486

Applicant(s)

SUNDARESAN ET AL.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/22/2005.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

The information disclosure statement filed 6/22/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Figure 1 is objected to under 37 CFR 1.83 (o) for lack of legends. See the circles and the rectangular boxes in Figure 1.

The active claims are 1-28.

Claims 1-9 and 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

In the communication filed on June 22, 2005, Applicants refer the Examiner to their specification in response to the section 112, second paragraph rejection. It should be noted that the rejection is directed to the claims and not the specification. It should further be noted that limitations in the specification should not be read into the claims. The statute clearly requires the claims to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejected claims recite a PNNI ATM network node for receiving and issuing information describing an address change. There is no recitation of how the received information is being used. There is no recitation of any change of address. Scope of the claims is not clear because nothing

is accomplished by receiving and issuing information by a network node. Applicants' invention is not giving the capability of a network node to receive and issue information. It appears that Applicants are not claiming their invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art in view of Eriksson (USP 6,243,384).

Claims 10-16 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksson (USP 6,243,384) in view of Rochberger (USP 6,208,623).

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

In the communication filed on June 22, 2005, Applicants agree with the Examiner that PNNIATM network is well known in the art as described by Applicants in his specification. Applicants further agree with the Examiner on the interpretation of Eriksson and Rochberger. Applicants' sole argument on patentability is that the address change is contained within SIG information. Firstly, SIG is prior art as admitted by Applicants on Figure 3. The claims give a label SIG to the address change information (see item b in claim 1 for example). The specification describes the acronym as a field within a payload. Applicants' Figure 3 shows that SIG field is prior art and is well known in Eriksson's PNNI ATM network. It would have been obvious to a person of ordinary skill in the art to give a label such as acronym SIG to the address change field in Eriksson so as to identify the address information field. Secondly, Applicants fail to

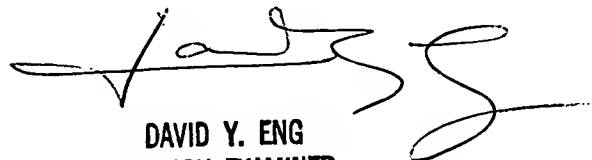
provide arguments as to why the acronym SIG is patentable over the applied references. In re Nielson, 816 F.2d 1567, 2 USPQ 1525 (Fed. Cir. 1987). The court held that simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability.

Nodoushani (USP 6,563,816) is cited to show a SIG field in a network packet.

See Figures 18-19.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



DAVID Y. ENG  
PRIMARY EXAMINER